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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91179897
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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INFORMATION BUILDERS, INC. :

Plaintiff, :

v. : Opposition No. 91179897

BRISTOL TECHNOLOGIES INC. :

Defendant. :
-----X

BRIEF FOR PLAINTIFF

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May 14, 2010

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I. INTRODUCTION

Plaintiff has opposed Defendant's application to register BRISTOL FOCUS for computer operating system software. BRISTOL FOCUS consists of "Bristol", the surname of the President of the Defendant, placed before "Focus", Defendant's registered trademark and house mark.

II. BACKGROUND

U.S. Trademark Application Serial No. 78/954,755 was filed by the Defendant on August 17, 2006 for registration of the trademark BRISTOL FOCUS for computer operating programs; computers and instructional manuals sold as a unit; and operating system programs" based on use of the mark in commerce under Section 1(a) of the Trademark Law.

On October 5, 2007, following publication of the mark, Opposition No. 91,179,897 was instituted alleging likelihood of confusion with, and dilution of, Plaintiff's registered FOCUS trademarks including

FOCUS, U.S. Trademark Registration No. 1,652,265 for computer programs for data base management. [P. Not. of Rel. II].

FOCUS, U.S. Service Mark Registration No. 2,606,298 for computer services, namely, providing online information to facilitate demonstration, test use, and ordering of computer software. [P. Not. of Rel. II].

FOCUS, U.S. Trademark Registration No. 2,821,942 for computer software for database management; computer software for use in decision support systems; computer software for use in enterprise reporting and analysis systems and for building applications for the management and tracking of data for enterprise reporting systems; computer database programs for use in connection with decision support, analysis, and reporting programs; computer software development tools for use in developing decision support, analysis, and reporting systems and applications; computer software, namely, client/server reporting, analysis and decision support tools; computerized database, reporting, and analysis software for use on corporate intranet web sites; enterprise server software for use in web based data publishing, reporting, and analysis solutions; computer software for accessing databases by means of global computer networks to generate reports; software development tools for making reporting and analysis available through global computer network worldwide websites and for extending the functionality of enterprise reporting and analysis systems on to global computer networks; and computer software for accessing and updating databases through global computer networks. [P. Not. of Rel. II].

FOCUS, U.S. Trademark Registration No. 2,989,088 for Business Accountability Software to Insure Compliance with Governmental Requirements and Standards. [P. Not. of Rel. II].

PC/FOCUS, U.S. Trademark Registration No. 1,300,245 for Diskettes Containing a Microprocessor Program for Use in Preparation of Reports and Graphs from Data Stored in a Personal Computer. [P. Not. of Rel. II]; [PX-10].

WebFOCUS, U.S. Trademark Registration No. 2,248,562 for computer programs for data base management. [P. Not. of Rel. II].

WebFOCUS, U.S. Trademark Registration No. 2,685,249 for Computer Software For Database Management; Computer Software For Accessing Databases By Means Of Global Computer Networks To Generate Reports; Software Development Tools For Making Reporting And Analysis Available Through Global Computer Network Worldwide Websites And For Extending The Functionality Of Enterprise Reporting And Analysis Systems On To Global Computer Networks; And Computer Software For Accessing And Updating Databases Through Global Computer Networks. [P. Not. of Rel. II].

Plaintiff has also been the owner of registrations covering PS/FOCUS for database management software, PM/FOCUS for software for use in preparation of reports and graphs from a database [PX-13,14], FOCUS VISION for pre-recorded computer programs used

to store images in a database and FOCUS FUSION for computer software for database management systems [pg. 22, line 16, pg. 23, line 5]; PX-28. These four registrations have been cancelled under Section 8.

In addition, Plaintiff is the owner by assignment of the trademark registrations:

FOCUS FORECASTING, U.S. Trademark Registration No. 2,223,450 for consulting services in the field of inventory management and control for businesses including the use of computers and computer techniques in the field of inventory management and control for businesses. [P. Not. of Rel. II].

FOCUS FORECASTING, U.S. Trademark Registration No. 2,223,457 for computer programs recorded on electronic media, namely tapes or discs, for use by businesses to plan inventory needs and to manage and control inventory. [P. Not. of Rel. II].

As shown below, FOCUS is a house mark of Plaintiff used in a family of software trademarks, both registered and unregistered.

Issue was jointed by the filing of Defendant's answer on November 14, 2007.

On April 3, 2008, based on Defendant's answers to interrogatories, Plaintiff filed an amended notice of opposition and a motion for summary judgment alleging that Defendant's allegation of use of the mark BRISTOL FOCUS in commerce was

untrue and constituted fraud on the Patent and Trademark Office.

Plaintiff was denied summary judgment of fraud, the Board finding that

"There remain genuine issues of material fact at least as to whether Defendant's statement of use as of the filing date, made at the time of its submission of its substitute specimen, was false and, if so, whether it was made with a reasonable and honest belief that it was true."

Defendant moved for leave to change the basis of its application to intent-to-use and for judgment on the pleadings with respect to Plaintiff's allegation of dilution. Defendant was granted leave to amend its basis to intent-to-use and denied judgment on the pleadings on the issue of dilution which was also found to raise issues of fact.

Thereafter, Plaintiff propounded further interrogatories which disclosed that Defendant's renewed allegation of use of the mark prior to its application filing date was based on a substitute specimen that Defendant fabricated six weeks after the original specimen was refused by the Examining Attorney. Defendant's declaration that the "The substitute specimen(s) was in use in commerce as of the filing date of the application" was false and was not made with a reasonable and honest belief that it was true.

III. THE RECORD

The record comprises the following evidence on behalf of Plaintiff:

1. Transcript of direct and cross examination Testimony of Gerald D. Cohen, President of Plaintiff since Plaintiff's inception in 1975 (hereinafter "Cohen, [pg. #, line #]");

2. Exhibits 1-87 referred to in the Cohen testimony;

3. Plaintiff's Notice of Reliance under Rule 2.120(j) dated November 25, 2009 (hereinafter "[P. Not. of Rel. I]");

4. Plaintiff's Notice of Reliance under Rule 2.122(d) dated November 25, 2009 (hereinafter "[P. Not. of Rel. II]");
and

5. Plaintiff's Notice of Reliance under Rule 2.122(e) dated November 25, 2009 (hereinafter "[P. Not. of Rel. III]").

6. Defendant's Notice of Reliance under Rule 2.122(e) dated January 29, 2010 (hereinafter "[D. Not. of Rel.]").

Defendant took no testimony.

IV. THE ISSUES

The issues to be determined are

1. Whether Defendant's declaration that "[t]he substitute specimen(s) was in use in commerce as of the filing date of the application" was false and was not made with a reasonable and honest belief that it was true thereby constituting fraud on the Patent and Trademark Office.

2. Whether there is a likelihood of confusion between Defendant's trademark BRISTOL FOCUS for the goods identified in its application, and any one or more of Plaintiff's family of "Focus" marks, namely, FOCUS, PC/FOCUS, WebFOCUS, and FOCUS FORECASTING, used on the variety of computer software products described above.

There is no issue concerning priority of use. Plaintiff first used its trademark FOCUS in 1975. Defendant took no testimony, and hence the earliest dates upon which it can rely is the filing date of its application, namely, August 17, 2006.

V. THE FACTS

A. Plaintiff's History and Products

Plaintiff's witness, Gerald D. Cohen, is one of the three founders of the Plaintiff, Information Builders, Inc. ("IBI"). Mr. Cohen has been IBI's President since the Company's inception in 1975 when IBI was launched as a software manufacturer to exploit the software products that its founders created. [pg. 4 lines 9-25]

In 1975 IBI had about 5 employees and occupied about 1,000 square feet of space. Today its New York offices have grown to 125,000 square feet where IBI employs about 700-800 people. [pg. 68, line 10] - [pg. 69, line 2]. IBI has annual sales in the neighborhood of \$300 million dollars of which FOCUS software products account for approximately one half, i.e., \$150 million.

[pg. 7 lines 14-22]. Today, IBI, still a privately held company, is believed to be the largest private software company in New York. [pg. 7, lines 5-13].

The fame which IBI and its FOCUS software have garnered are evidenced by their press coverage over the years including for example, articles in Hoover's profiles [PX-2], Software Magazine [PX-6], Computer Reseller News [PX-38], Database Programming and Design [PX-50], Enterprising Computing Magazine [PX-51], Mid-Range Systems Magazine [PX-52], DEC Professional [PX-53], DBMS [PX-54], Cranes [PX-55], Main Frame Executive [PX-56], and DM Review [PX-39]. Wikipedia currently maintains a section devoted to IBI and its FOCUS software [PX-1].

In the year 2000, then New York City Mayor Rudolf Giuliani issued a proclamation to IBI for its 25 years of software innovation. [pg. 57, line 6] - [pg. 58, line 24]. IBI published a booklet commemorating its 25th anniversary describing its history including that of FOCUS software. A photo of Mayor Giuliani and Mr. Cohen with the Proclamation appears on page 35 of the booklet.¹ [pg. 57, line 6- pg. 59, line 11];[PX-76].

The very first software product produced by IBI in 1975 was called FOCUS. Later the FOCUS software spawned a family of other software products under the FOCUS family name. [pg. 5 lines 2-8]. IBI has been delivering software to its customers under the

¹ An uncorrected typographical error in the transcript of Mr. Cohen's testimony refer to page 5 instead of 35.

FOCUS trademark continuously since 1975. [pg. 60, line 10] - [pg. 61, line 18]; [PX-77,78,79]. WebFOCUS has been used as a trademark of IBI since 1996. [PX-80].

In 1975 the IBM main frame computer was the one major computer. FOCUS was created to manage information and allow people to report information on a daily basis, and to run various applications using information stored in a computer. [pg. 5, lines 9-17]. IBI produced a manual for the original FOCUS software. An available copy has a copyright date of 1975 and a revision date of 1976. [PX-3]. The FOCUS software to which this manual applies is still being sold by Information Builders, Inc. FOCUS remains a very widely well known product. [pg. 8, line 11 - [pg. 9, line 6].

With the advent of personal computers, IBI developed an IBI Micro Products Family. Some of the products were identified by trademarks such as PC/FOCUS and PM/FOCUS. [pg. 13, line 8] - [pg. 14] - line 11]; [PX-7]. IBI's FOCUS software and its development lead to an Internet version named WebFOCUS in 1996.

FOCUS software is not an operating system but runs in collaboration with operating systems. [pg. 71 line 20] - [pg. 72, line 18]. In fact, FOCUS software runs on almost all computer operating systems, including Windows, Unix and Linux. [pg. 10 lines 17] - [pg. 11, line 3], and even IBM's recent ZIIP engine [pg. 56, line 15 - pg. 57, line 5]; [PX-75]. In addition

to FOCUS, members of the family of FOCUS software products have included

WebFOCUS [pg. 31, line 13] - [pg. 33, line 11]; [PX-33,34,35,36,37].

PC/FOCUS [pg. 14, line 18] - [pg. 15, line 12]; [PX-8];

PM/FOCUS [pg. 16, line 16] - [pg. 17, line 9];

PS/FOCUS - [PX-20];

FOCUS VISION [PX-21];

FOCUS for DOS [pg. 13, line 15] - [pg. 14 line 20]; [PX-22];

FOCUS for OS/2 [pg. 23, line 23] - [pg. 24, line 6]; [PX-23];

FOCUS SIX [pg. 17, line 17] - [pg. 18, line 11]; [PX-15,16,17];

FOCUS/EIS - [PX-19];

FOCUS SIX EIS [pg. 18, line 12] - [pg. 19, line 14]; [PX-15,16];

FOCUS for Windows - [PX-24,25];

FOCUS for Main Frame - [PX-31,32];

FOCUS FORECASTING [pg. 28, line 24] - [pg. 29, line 14]; [PX-29,30].

IBI printed labels for each member of its family of FOCUS products. See, e.g., [PX-8 (PC/FOCUS), [PX-12 (PM/FOCUS), [PX-20 (PS/FOCUS), [PX-17 (FOCUS 6), [PX-21 (FOCUS VISION), [PX-19

(FOCUS/EIS), [PX-24 (FOCUS for Windows), and [PX-29 (FOCUS for Main Frame)].

To promote its FOCUS software, IBI provides educational courses which teach the use of FOCUS on various operating systems. [pg. 36, line 16] - [pg. 39, line 3]; [PX-40,41]. IBI also runs hands-on workshops in various cities through the U.S. for its WebFOCUS software [PX-47]. IBI sponsors local user groups [pg. 54, line 25] - [pg. 56, line 10]; [PX-73,74]. For the past 25 years, IBI has annually sponsored a national conference attended by FOCUS users. [pg. 39, lines 7-21]; [pg. 40, line 24] - [pg. 43, line 4]; [PX-42,45,46,48].

IBI has published various guides, instruction manuals, periodic newsletters, fact sheets and technical journals directed to its FOCUS software, examples of which include the FOCUS Manual [PX-3], General Information Guides, [PX-4,5], Fact Sheet, [PX-9], Focus News [PX-43], and Focus Systems Journal [PX-44].

IBI has advertised its FOCUS products since it began business. Initially, IBI placed printed advertisements in magazines. See, e.g. [PX-49]. Advertising was later done by email and online. [pg. 44, line 6] - [pg. 45, line 18]; PX-71. IBI's annual marketing budget for advertising is about 5-8 million dollars approximately 75% of which is spent promoting FOCUS products. [pg. 61 line 19] - [pg. 62, line 7].

IBI has also published customer profiles describing how some of its customers used FOCUS software to solve a particular business problem. Each profile is reviewed and approved by the customer before being published.

Examples of the many different business problems solved through the use of FOCUS software include monitoring the bidding process during an auction of tulips [PX-17]; financial reporting [PX-18]; U.S. Postal Service operations [PX-19]; health care monitoring [PX-26]; construction of an executive information system [PX-27]; containment of thunderstorm damage by an electric utility company [PX-58]; tracking of criminal justice probation programs [PX-59]; truck manufacturing [PX-60]; automobile parts supply maintenance [PX-61]; medical fraud protection [PX-62]; agricultural and construction equipment quality and reliability [PX-63]; water system and pool/spa production and inventory management [PX-64]; custom marketing research information access PX65]; graphical sales information systems [PX-66]; manufacture of computer workstations and servers [PX-67]; sales of salt [PX-68]; court case tracking [PX-69]; and insurance brokerage [PX-70].

In addition to paid advertising in print and on the websites of others, IBI advertises its FOCUS software on its own website. [pg. 53, line 13] - [pg. 54, line 18];[PX-71,72].

As mentioned above, IBI has been granted the following trademark registrations by the Patent and Trademark Office:

FOCUS, U.S. Trademark Registration No. 1,652,265 for computer programs for data base management. [P. Not. of Rel. II.

FOCUS, U.S. Service Mark Registration No. 2,606,298 for computer services, namely, providing online information to facilitate demonstration, test use, and ordering of computer software. [P. Not. of Rel. II].

FOCUS, U.S. Trademark Registration No. 2,821,942 for computer software for database management; computer software for use in decision support systems; computer software for use in enterprise reporting and analysis systems and for building applications for the management and tracking of data for enterprise reporting systems; computer database programs for use in connection with decision support, analysis, and reporting programs; computer software development tools for use in developing decision support, analysis, and reporting systems and applications; computer software, namely, client/server reporting, analysis and decision support tools; computerized database, reporting, and analysis software for use on corporate intranet web sites; enterprise server software for use in web based data publishing, reporting, and analysis solutions; computer software for accessing databases by means of global computer networks to generate reports; software development

tools for making reporting and analysis available through global computer network worldwide websites and for extending the functionality of enterprise reporting and analysis systems on to global computer networks; and computer software for accessing and updating databases through global computer networks. [P. Not. of Rel. II].

FOCUS, U.S. Trademark Registration No. 2,989,088 for Business Accountability Software to Insure Compliance with Governmental Requirements and Standards. [P. Not. of Rel. II].

WebFOCUS, U.S. Trademark Registration No. 2,248,562 for computer programs for data base management. [P. Not. of Rel. II].

WebFOCUS, U.S. Trademark Registration No. 2,685,249 for Computer Software For Database Management; Computer Software For Accessing Databases By Means Of Global Computer Networks To Generate Reports; Software Development Tools For Making Reporting And Analysis Available Through Global Computer Network Worldwide Websites And For Extending The Functionality Of Enterprise Reporting And Analysis Systems On To Global Computer Networks; And Computer Software For Accessing And Updating Databases Through Global Computer Networks. [P. Not. of Rel. II].

PC/FOCUS, U.S. Trademark Registration No. 1,300,245 for Diskettes Containing a Microprocessor Program for Use in

Preparation of Reports and Graphs from Data Stored in a Personal Computer. [P. Not. of Rel. II].

Plaintiff was the owner of registrations covering PS/FOCUS for database management software, PM/FOCUS for software for use in preparation of reports and graphs from a database, and FOCUS VISION for pre-recorded computer programs used to store images in a database. These three registrations have been cancelled under Section 8.

In addition, Plaintiff is the owner by assignment of the registered trademark FOCUS FORECASTING for:

FOCUS FORECASTING, U.S. Trademark Registration No. 2,223,450 for consulting services in the field of inventory management and control for businesses including the use of computers and computer techniques in the field of inventory management and control for businesses. [P. Not. of Rel. II].

FOCUS FORECASTING, U.S. Trademark Registration No. 2,223,457 for computer programs recorded on electronic media, namely tapes or discs, for use by businesses to plan inventory needs and to manage and control inventory. [P. Not. of Rel. II].

IBI continually monitors the usage and or abuse of its FOCUS trademarks worldwide and takes action to enforce its trademark rights. [pg. 63, lines 16-21]. Would-be conflictors are placed on notice before an opposition is commenced. [pg. 65, line 4] - [pg. 7]. In some cases notice results in cessation of

the conflicting use. [pg. 65, line 12] - 68, line 9]; [PX-82-87].

IBI has brought approximately 300 oppositions in the Patent and Trademark Office against applications to register marks confusingly similar to FOCUS. [pg. 64, line 7] - [pg. 65, line 3]; [PX-81]; [P. Not. of Rel. III].

B. Defendant and its Trademark Application

David Bristol is President of Defendant, Bristol Technologies, Inc. [Affidavit of David Bristol filed October 27, 2008].

The first alleged use of the mark BRISTOL FOCUS was in a newspaper ad published in the Bozeman Daily Chronicle newspaper on July 25, 2006 associating the mark with Bristol Technologies and its product line. [P. Not. of Rel. I, Interrogatory Answer No. 30]. From the time the ad was placed until the application was filed, the only activity to bring about use of the mark was applicant's correspondence with its attorney. [P. Not. of Rel. I, Interrogatory Answer No. 31].

On August 17, 2006, Defendant filed the opposed application for trademark registration based on use of the mark, supported by a specimen consisting of the July 25, 2006 newspaper ad.

In an office action dated January 12, 2007, the Examining Attorney objected to the specimen as unacceptable to show trademark use, carefully explained why the specimen ad submitted

by Defendant was not adequate to show trademark use, and set forth examples of specimens that show use of a mark on goods or packaging. Finally, the Examining Attorney suggested that if Defendant had not made use of the mark in commerce, the basis of the application could be amended from use under Section 1(a) to intent to use under Section 1(b).

Approximately six weeks after the office action was issued, on February 22, 2007 (the record does not show when Defendant learned of the office action from its attorney), Defendant created an image of the words "Bristol" and "Focus" followed by the initials "TM" and "SM" which Defendant's President, David W. Bristol, photographed on March 26, 2007. [P. Not. of Rel. I, Interrogatory Answer No. 32]. This photo of the image was filed in the Patent and Trademark Office on July 15, 2007 as a substitute specimen with a declaration that "[t]he substitute specimen(s) was in use in commerce as of the filing date [August 17, 2006] of the application".

As of November 18, 2007, the service date of Defendant's answers to Plaintiff's First interrogatories, [P. Not. of Rel. I], Bristol Technologies, Inc. was still in the process of developing a proprietary design computer system (hardware) which would use the operating system Bristol Focus. [P. Not. of Rel. I, Interrogatory Answer No. 1]. This incomplete computer

hardware and operating system comprised Defendant's entire product line. [P. Not. of Rel. I, Interrogatory Answer No. 2].

As of November 18, 2007, Defendant had made no sales of any of its products. [P. Not. of Rel. I, Interrogatory Answer No. 7], Defendant had no distributors, representatives, or salespeople for its products. [P. Not. of Rel. I, Interrogatory Answer No. 14], and no purchase, license, or use of Defendant products had occurred. [P. Not. of Rel. I, Interrogatory Answer No. 26].

As of March 24, 2008 (the service date of Defendant's answer to Plaintiff's second set of interrogatories) the BRISTOL FOCUS computer operating system program had not been completed, [P. Not. of Rel. I, Interrogatory Answer No. 29], no orders had been received in response to the advertisement in The Bozeman Chronicle submitted with Defendant's application to register BRISTOL FOCUS, [P. Not. of Rel. I, Interrogatory Answer No. 27], and no computer systems bearing the trademark BRISTOL FOCUS had been shipped by Defendant. [P. Not. of Rel. I, Interrogatory Answer No. 28].

VI. ARGUMENT

A. Fraud on the Patent and Trademark Office

The standard by which the question of fraud must be determined was set forth in In re Bose Corporation, 580 F.3d 1240, 91 U.S.P.Q. 2d (Fed. Cir. 2009). It is insufficient to

merely prove that the Defendant knew or should have known that the allegation of use of the mark prior to the filing date of the application was false. Subjective intent to deceive must be shown.

"A trademark is obtained fraudulently under the Lanham act only if the Defendant or registrant knowingly makes a false, material representation with the intent to deceive the PTO." Id.

However, one need not be a mind reader to determine whether fraud was committed. Indirect and circumstantial evidence of intent to deceive the Patent and Trademark Office can suffice in the absence of direct evidence of Defendant's intent.

"Of course, because direct evidence of deceptive intent is rarely available, such intent can be inferred from indirect and circumstantial evidence. But such evidence must still be clear and convincing, an inferences drawn from lesser evidence cannot satisfy the deceptive intent required." Id.

The evidence in shows:

1. The application was filed on August 17, 2006. In order for an application based on use to have been valid, first use of the mark in commerce must have taken place prior to the filing date.

2. In the original application, as filed, Defendant alleged first use of the mark in commerce on July 25, 2006.

3. The specimen submitted with the application that was filed on August 17, 2006 was a classified ad, which appeared

under "Legals" in the Bozeman Daily Chronicle published July 25, 2006. The ad announced that Defendant, Bristol Technologies, Inc. was giving notice that it "intends to use" the trademark "Bristol Focus".

It follows from the statement of intent in the classified ad that, as of July 25, 2006, Defendant had not yet used the mark. However, the statement of intent in the ad did not rule out the possibility of use of the mark during the approximately three weeks between July 25, 2006 when the ad was published and August 17, 2006 when the application was filed. However, that no use of the mark was made in that period is evident from Applicant's response to Plaintiff's Interrogatories Nos. 1, 7, 14, 27 and 28. Still, mere absence of use in that time period would not necessarily prove an intent to deceive the Patent and Trademark Office.

In an office action dated January 12, 2007, the Examining Attorney objected to the copy of the classified add as an unacceptable specimen for showing trademark use, carefully explained why the specimen ad submitted by Defendant was not adequate to show trademark use, and set forth examples of specimens that show use of a mark on goods or packaging. Finally, the Examining Attorney suggested that if Defendant had not made use of the mark in commerce, the basis of the

application could be amended from use under Section 1(a) to intent to use under Section 1(b).

Defendant did not, at that time, amend to Section 1(b). Instead, Defendant responded to the examiner by fabricating a substitute specimen of the mark in the form of software for displaying the mark on a computer screen on February 22, 2007, at most, six weeks after the mailing date of the January 12, 2007 office action. Thereafter, the substitute specimen was photographed on March 26, 2007.

Intent to deceive the PTO is demonstrated by Defendant's filing of a response on July 15, 2007 to the January 12, 2007 office action with a sworn declaration that the specimen that had first been created on February 22, 2007 and photographed on March 26, 2007 was in use in commerce as of the August 17, 2006 filing date of the application.

When the fraudulent declaration was filed on July 15, 2007, no computer systems had been shipped. [P. Not. of Rel. I, Interrogatory Answer No. 28], no computer operating program had been completed, and no computer operating program had been distributed or shipped [P. Not. of Rel. I, Interrogatory Answer No. 29]. In fact, the only use of the mark which Defendant believed that it made between the time of conception of the mark on July 20, 2006 and the filing of the application on August 17,

2006 was its placement of the newspaper ad which was run in the Bozeman Daily Chronicle on July 25, 2006.

Defendant may not have understood when the application was signed on or about August 17, 2006 that running of the classified ad did not constitute use of the mark sufficient to obtain a trademark registration. However, the detailed explanation given by the Examining Attorney in the January 12, 2007 office action followed by Applicant's fabrication of a new specimen no more than six weeks after learning of the initial refusal constitute clear and convincing evidence that Defendant sought to mislead the Patent and Trademark Office with the July 15, 2007 response which caused the Examining Attorney to pass the application to publication.

Plaintiff respectfully submits that the evidence of intent to deceive the Patent and Trademark Office as to use of the mark is clear and convincing and passes the Bose test. Accordingly Opposer requests that the opposition be sustained on the ground of Defendant's fraud.

B. Likelihood of Confusion Between the Mark BRISTOL FOCUS and the Registered Trademark FOCUS

The following analysis of the duPont factors, In re E.I. duPont de Nemours & Co., 177 USPQ 563, 567 (CCPA 1973), will make clear that a likelihood of confusion exists between

Plaintiff's and Defendant's marks as applied to their respective goods.

The DuPont factors:

1. The Similarity or Dissimilarity of the Marks in their Entireties as to Appearance, Sound, Connotation and Commercial Impression.

Defendant's mark consists of two terms. The first is the surname of Defendant's president. The second term is Plaintiff's registered trademark. Surnames are not considered distinctive and are normally require a disclaimer.

FOCUS is a house mark of Plaintiff. Consumers are likely to consider Defendant's BRISTOL FOCUS to be a member of Plaintiff's family of trademarks such as WebFOCUS and PC/FOCUS, and formerly FOCUS FUSION, FOCUS VISION, PS/FOCUS and PM/FOCUS which Plaintiff has used and registered in the past.

With respect to the connotations of, and commercial impressions made by, the two marks, it should be noted that FOCUS is totally arbitrary as applied to Plaintiff's software. Thus, those familiar with Plaintiff's products recognize FOCUS as Plaintiff's brand name for software, and nothing else. This being the case, a prospective customer seeing Defendant's mark, BRISTOL FOCUS, may very well believe that it is another product line from Plaintiff.

The same analysis applies to the sound of the two marks. The term "Bristol" is likely to be disregarded, because it is a

surname and the sound of "Focus" is highly recognizable as Plaintiff's mark. The sound that will make an impression is the arbitrary word "Focus".

In view of the history of Plaintiff using a family of "FOCUS" marks, one would reasonably expect that Plaintiff would adopt other marks including the word "FOCUS" combined with different prefixes and suffixes. No doubt, Plaintiff's many customers are aware of this pattern of Plaintiff's trademarks and are likely to believe that Plaintiff has added another similar mark to its line.

2. The Similarity or Dissimilarity and Nature of the Goods or Services as Described in an Application Or Registration or in Connection with which a Prior Mark is in Use.

Defendant's software products are operating systems with which other software programs, such as Plaintiff's FOCUS programs, collaborate to accomplish their functions. Both types of products are software products and are used by the same consumers. That is, all users of Plaintiff's FOCUS software must also use an operating system. It is for that reason that FOCUS has been produced in versions to run on almost every operating system. Use of the marks of both parties on operating systems (operating software) is not a prerequisite to a finding of likelihood of confusion. Likelihood of confusion is present when a latecomer uses on operating system software the same or a

similar mark that has previously been used and registered for software by another. Eclipse Associates Limited v. Data General Corporation, 894 F.2d 1114, 13 U.S.P.Q. 2d 1885 (9th Cir. 1990).

It is well settled that goods and services need not be identical or even competitive in order to support a finding of likelihood of confusion; it is sufficient that the goods and services be related in some manner or that the circumstances surrounding their marketing are such that they would likely be encountered by the same persons under circumstances that could give rise to the mistaken belief that they emanate from or are associated with the same source. See, In re Peebles Inc., 23 USPQ2d 1795, 1796 (T.T.A.B. 1992); Monsanto Co. v. Enviro-Chem Corp., 199 USPQ 590, 596 (T.T.A.B. 1978).

The issue is not whether consumers would confuse the goods, but rather whether they would be confused as to the source of the goods and services. See In re Rexel Inc., 223 USPQ 830 (T.T.A.B. 1984). It is sufficient that the goods and services be related in some manner, or that the circumstances surrounding their use be such, that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of the respective goods. See In re Martin's Famous

Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); In re Melville Corp., 18 USPQ2d 1386 (T.T.A.B. 1991); In re International Telephone & Telegraph Corp., 197 USPQ 910 (T.T.A.B. 1978).

Those acquainted with applicant's software (e.g., database management software would readily conclude that operating system software bearing an identical or similar mark emanates from, or is sponsored by or affiliated with, the same source.

3. The Similarity or Dissimilarity of Established, Likely-To-Continue Trade Channels.

Plaintiff's goods are broadly described in its registrations as are the Defendant's goods in its application. There is no restriction as to channels of trade or intended consumers.

Plaintiff's goods are computer software programs designed to run on computers on almost any operating system. Defendant's goods consist of operating systems and computers that use the operating systems. When there are no limits on channels of trade or classes of consumers in identifications, and there are none in the involved identifications, it must be assumed that the goods can be marketed to all typical classes of consumers for such goods and through all customary channels of trade for such goods. In re Elbaum, 211 USPQ 639, 640 (T.T.A.B. 1981).

4. The Conditions Under which and Buyers to Whom Sales are Made, i.e., Impulse vs. Careful Sophisticated Purchasing

There is no direct evidence in the record as to the level of sophistication of Plaintiff's or Defendant's goods or whether or not purchases of would be made on impulse.

5. The Fame of the Prior Mark (Sales, Advertising, Length of Use).

By every criterion, sales, advertising, and length of use, Plaintiff's mark is extremely famous in the community familiar with computer software. This fame is brought about by Plaintiff's continuous use of its FOCUS trademark since 1975.

Plaintiff devotes about 75% of its 5 to 8 million dollar annual advertising budget to its FOCUS products.

Plaintiff's FOCUS software has been written about in the computer press and described in Wikipedia.

FOCUS software is promoted at local and national conferences, and has users groups throughout the United States.

Plaintiff has published periodic newsletters and technical journals devoted to FOCUS.

Annual sales of FOCUS software are approximately 150 million dollars.

Plaintiff is believed to be the largest computer software company in New York City, and Plaintiff has received a congratulatory proclamation from Mayor Giuliani.

Plaintiff has not only registered its trademark FOCUS, but has also registered six additional "FOCUS" trademarks for computer software, owns four trademark registrations for FOCUS, two registrations for WebFOCUS, a registration of PC/FOCUS and is the owner by assignment of two registrations of FOCUS FORECASTING, one for computer software and the other for computer consulting services.

Certainly, by any definition, Plaintiff's mark is "famous".

6. The Number and Nature of Similar Marks in use on similar goods.

Defendant took no testimony, and hence there is no evidence of use (even by Defendant) of any trademark, for computer software, including the word "Focus", other than the uses by Plaintiff. When IBI has become aware of an infringing trademark it has taken action. [pg. 63, line 24] - [pg. 64, line 6], including the commencement of some 300 opposition proceedings [P. Not. of Rel. III].

7. The nature and extent of any actual confusion, and

8. The length of time during and condition under which there has been concurrent use without evidence of actual confusion.

It is understood that Defendant has never actually used its mark. Thus, the absence of actual confusion is not surprising.

9. The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark).

Plaintiff owns a "family" of FOCUS marks for its various software products. [pg. 5 lines 2-8]; [PX-8,15,16,17,18,19,20,22,23,24,25,29,30,31,32,33,34,35,36,37]. Thus, Defendant's mark might very well be taken as just another one of Plaintiff's family of marks.

Moreover, Plaintiff sells a wide variety of software products, which perform many functions, on different platforms, all under its various "Focus" marks.

10. Market Interface

This factor as defined in duPont is not applicable to the current situation.

11. The Extent to which Plaintiff has a Right to Exclude Others from use of its Mark on its Goods

Plaintiff has been diligent in objecting to the use of "Focus" trademarks by others on computer software. As a result of its activity, Plaintiff has firmly established its right to exclude others from using "Focus" trademarks on software.

More specifically, Plaintiff has, since 1985, filed approximately three hundred Notices of Opposition in the Patent and trademark Office, and three petitions for cancellation (Ex. 30). In almost all cases which have been terminated, the opposition has been sustained (by default or concession on the part of the Defendant), and the cancellation petitions have been

granted. In some cases, the opposition proceedings have been settled, and withdrawn, after the identification of goods in the application was amended to make clear that the mark is not used on computer software. Plaintiff has also litigated infringement of its FOCUS trademark in the U.S District Court for the Southern District of New York and obtained a consent judgment of infringement. [P. Not. of Rel. III].

This history makes two things clear. Plaintiff has gone through great expense over the years to protect its rights in the trademark FOCUS and its other "Focus" trademarks. In addition, this history shows that the industry has recognized Plaintiff's rights in "Focus" trademarks as applied to computer software. It is submitted that there can be no more persuasive proof of the strength of Plaintiff's rights than recognition of those rights by those active in the market place.

12. The Extent of Potential Confusion, i.e., Whether de Minimis or Substantial

The only portion of Defendant's mark which is not a surname is the word "Focus". This portion of Defendant's mark is identical to Plaintiff's trademark FOCUS, and identical to the arbitrary portions of Plaintiff's other "Focus" trademarks. Moreover, Defendant's software is of the type which all users of Plaintiff's FOCUS software concurrently use with it. All of Plaintiff's FOCUS software runs in collaboration with operating

system software. Consequently, the potential for confusion between the marks of the parties is substantial.

VII. SUMMARY AND CONCLUSION

Defendant seeks to register BRISTOL FOCUS for operating system software alone or installed on computer hardware. After misrepresenting to the Patent and Trademark Office that it had used the mark, no matter how innocently, it willfully attempted to deceive the Patent and Trademark Office as to that use thereby committing fraud.

Plaintiff owns and uses a variety of "Focus" trademarks for software adapted to run in collaboration with almost any operating system software. Defendant intends to use the mark on operating system software creating a substantial likelihood that users of the respective products of the parties will be confused as to the source or sponsorship of Defendant's operating system software. The likelihood of confusion between Defendant's mark and Plaintiff's family of "Focus" marks is evident.

Consequently, this opposition should be sustained and registration denied to Defendant.

Respectfully,
INFORMATION BUILDERS INC.

Date: May 14, 2010

By: /Howard F. Mandelbaum/
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CERTIFICATE OF SERVICE

It is hereby certified that a copy of the foregoing BRIEF FOR PLAINTIFF has been sent this 14th day of May, 2010, by first class mail to:

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/Howard F. Mandelbaum/
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